

UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF NEW YORK

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BBC INTERNATIONAL LTD.,

Plaintiff,

-against-

LUMINO DESIGNS, INC.,

Defendant.  
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MEMORANDUM OPINION  
and ORDER

CV 05-4179 (JFB) (ETB)

The order, dated January 31, 2006, granted bifurcated discovery on liability and damages, and denied a bifurcated trial, without prejudice to renewal before the assigned Article III judge.<sup>1</sup> That portion of the order relating to a formal bifurcation of discovery is now vacated.

Subsequent to the entry of the order of January 31, 2006, entered without any opposition, defendant Lumino requested, and the plaintiff BBC International Ltd. consented to, the submission of opposition to BBC's January 13, 2006 motion to bifurcate. That fully briefed motion is now before me.

I further note that following the fully briefed motion on bifurcation, Lumino, on February 23, 2006, filed a motion to transfer this action, pursuant to 28 U.S.C. § 1404(a), to the Northern District of Illinois, where an earlier filed patent action is pending. Although the plaintiff has not yet had an opportunity to submit opposition, the application raises substantial issues as to where this action will be litigated. For this reason, the filing of this motion places me in the awkward position, at least potentially, of binding another district with respect to the conduct of discovery. I would prefer to await the decision of Judge Bianco on the transfer motion before entering a

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<sup>1</sup> I note that on February 24, 2006 this action was reassigned to Joseph F. Bianco, D.J.

final order on the bifurcation motion now before me.

For the foregoing reasons, pending the outcome of the pending motion to transfer, I direct that the parties engage in discovery limited to liability issues. I do this because there are substantial issues with respect to the infringement issue and because damages discovery will undoubtedly involve plaintiff's customers, Target Corporation, Footstar Corporation, Kmart Holding Corporation and Stride Rite Corporation. These entities and other customers are not parties to the within action and, therefore, discovery would have to be carried out under Rule 45 in the absence of consent. This non-party discovery will make damages discovery more burdensome and expensive to all concerned.

Accordingly, BBC's motion to bifurcate discovery is denied, without prejudice to renewal,<sup>2</sup> depending on the outcome of the pending motion to transfer this action to the Northern District of Illinois. Pending that determination, however, all discovery shall be limited to liability issues for the reasons set forth above.

SO ORDERED:

Dated: Central Islip, New York  
February 28, 2006

/s/ E. Thomas Boyle  
E. THOMAS BOYLE  
United States Magistrate Judge

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<sup>2</sup> In the event of a renewal of this motion, upon agreement between the parties, they may merely write and request that all papers submitted be reinstated, with or without supplementation, or they may submit a new motion and briefs.